

REMARKS

Claims 40, 49, 51, 55, 57-58, 60, 65, 67 and 75-77 have been amended, and Claims 78-79 have been added. Claims 40-79 are currently in the application, and presented for examination. In view of the foregoing amendments, and the remarks that follow, Applicants respectfully request reconsideration.

Claim Objections

On page 2 of the Office Action, the Examiner raises an objection to the claims. More specifically, the Examiner notes that the claims recite "an optical disc", but then sometimes refer back to it as "the disc", rather than as "the optical disc". The Examiner asserts that this presents a problem of antecedent basis. Applicants respectfully disagree. Under customary U.S. claim-writing practice, when referring back to a previously-recited element, it is generally preferable to drop adjectives used in the original recitation of the element, except where the adjectives are necessary to distinguish that element from another element. For example, where a claim recites "an optical disc", it is acceptable and often even preferred that it be thereafter referred to as "the disc" rather than "the optical disc", unless the claim also recites some other "disc". In the present application, the claims recite "an optical disc" but do not go on to positively recite any other "disc". Thus, the references to "the disc" were entirely proper and did not present any ambiguity as to which recited disc was being referenced, because the claims recite only one disc. In other words, and contrary to the assertions in the Office Action, use of "the disc" in Applicants' claims did not present any problem of antecedent basis.

Nevertheless, and solely as a courtesy to the Examiner, the foregoing claim amendments replace all references to "the disc" with "the optical disc". These changes do not cause any alteration whatsoever to the scope or meaning of any claim. It is respectfully submitted that these changes should resolve the concerns of the Examiner, and notice to that effect is respectfully requested.

Comment Regarding the Term "Optical Disc Data Reader"

In the Office Action, the Examiner asserts that the term "optical disc data reader" encompasses all types of disc readers, including not only a CD-ROM device (which reads all data), but also an audio-only disc reader such as a CD-DA device (which by definition reads only audio data). However, in making this statement, the Examiner is considering the term "optical disc data reader" in a vacuum, rather than in the context of the present application. MPEP §2111 explains that:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." The Federal Circuit's en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). . . . 415 F.3d at 1316, 75 USPQ2d at 1329.

Applying this standard to the present situation, it is respectfully submitted that when the term "optical disc data reader" is considered "in light of the specification as it would be interpreted by one of ordinary skill in the art", it is clear that the term "optical disc data reader" is not used as

broadly as the Examiner asserts, but instead is intended to encompass optical disc readers other than audio-only readers (such as CD-DA devices).

Independent Claim 65

Independent Claim 65 stands rejected under 35 U.S.C. §102 as anticipated by Babowicz PCT Patent Application Publication No. 2002/075735. This ground of rejection is respectfully traversed, for the following reasons. In MPEP §2131, the PTO quotes relevant case law regarding §102, and explains that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In other words, to anticipate a claim under §102, a reference (1) must disclose each and every element recited in the claim, and (2) must also disclose these elements arranged in the manner recited in the claim. Applicants' Claim 65 recites:

A method of generating data for writing onto a session of an optical disc, the session having a main data channel and a plurality of sub-code channels, the method comprising:

generating primary data representative of m primary track(s) for the optical disc ($m > 1$), for writing to the main data channel of the session;

generating alternate data representative of n alternate track(s) for the optical disc ($n > 1$), for writing to the main data channel of the session; and

assembling a table of contents (TOC) for the optical disc, the TOC containing disc access control information which, when written to an optical disc, indicates to an optical disc data reader that there are m tracks in total written upon that optical disc.

In the Office Action, the portions of Babowicz identified in the rejection of Claim 65 do not contain a clear and unambiguous disclosure that audio data and computer-type data can both be stored on the same session. But even if Babowicz was not silent on this point, Babowicz would not state that audio data and computer-type data can both be stored in the same session, because Babowicz cannot operate with only a single session. This is because, under the "Red Book" industry standards that govern the nature of the data written to a compact disc (CD), audio material and computer-type data files cannot be present in the same session. In Babowicz, what the Examiner refers to as "primary" tracks are audio tracks, and what the Examiner refers to as "alternate" tracks are computer-type data files. Consequently, they cannot be present in a single session. The fact that Babowicz places these two different types of data in two different sessions is reflected in Figure 2 of Babowicz, where the ISO 9660 files are in the second session. In contrast, Claim 65 explicitly recites primary and alternate data for the same session.

The indicated portions of Babowicz thus do not appear to disclose each and every element recited in Claim 65, and Babowicz therefore does not meet the standard for anticipation under §102 that has been established by the courts and that is summarized in MPEP §2131.

Claim 65 is therefore believed to be allowable over Babowicz, and notice to that effect is respectfully requested.

Independent Claim 40

Independent Claim 40 stands rejected under 35 U.S.C. §103 as obvious in view of a proposed combination of teachings from the Babowicz publication and Alcalay U.S. Patent No. 6,988,206. This ground of rejection is respectfully traversed. In this regard, the PTO specifies in MPEP §2142 that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Applicants respectfully submit that Babowicz and Alcalay fail to establish a *prima facie* case of obviousness under §103 with respect to Claim 40, for the following reasons. Claim 40 recites:

An optical disc comprising:

a session having a main data channel and a plurality of sub-code channels, the session including at least one primary track and at least one alternate track each formed within the main data channel; and

disc data access information, stored upon the optical disc, and which is read and utilized only by an optical disc data reader, the disc data access information being such as to prevent location of the, or at least one of the, primary track(s), when the optical disc

is read by the optical disc data reader, and to direct the optical disc data reader instead to the, or an associated, alternate track.

The Examiner admits that "Babowicz is silent in disclosing that both the primary track and the alternate track are in a single session". But even if Babowicz was not silent on this point, Babowicz would not state that audio data and computer-type data can both be stored in the same session, because Babowicz cannot operate with only a single session. More specifically, as discussed above, under the "Red Book" standards that govern the nature of data written to a CD, audio material and computer-type data files cannot both be present in the same session. In Babowicz, what the Examiner refers to as "primary" tracks are audio tracks, and what the Examiner refers to as "alternate" tracks are computer-type data files. Therefore, they cannot all be present in a single session. The fact that Babowicz puts these two different types of data in two different sessions is reflected in Figure 2 of Babowicz, where the ISO 9660 files are in the second session. The Examiner asserts that putting these different types of files in the same session is merely a matter of "design choice", but Applicants disagree, because that approach is contrary to industry standards (such as the "Red Book"). After admitting that Babowicz does not disclose putting both audio files and computer-type data files into a single session, the Examiner turns to Alcalay, and asserts that Alcalay discloses this. But Applicants disagree.

Alcalay discloses a method for protecting data recorded on an original storage medium (disc) against unauthorized copying. This is achieved by altering the Q-channel data (in a single session or in more than one session) so that an audio-only disc reader will properly read the data, but an optical disc data reader will encounter errors that prevent the audio information from being played correctly. In other words, an optical disc data reader will locate the tracks, but the tracks will be read only with intentional errors that will introduce, for example, discontinuities and distortion into the audio material when it is played. In contrast, Claim 40 calls for "the disc data access information being such as to prevent location of the, or at least one of the, primary track(s), when the optical disc is read by the optical disc data reader". In other words, Claim 40

specifies that an optical disc data reader will be completely prevented from locating the recited primary tracks, and thus will not be aware of their existence. This is different from Alcalay.

Thus, the proposed combination of Babowicz and Alcalay will not result in the subject matter recited in Claim 40. In particular, the proposed combination does not yield a single session that includes both "primary" tracks and "alternate" tracks in the main data channel of that session, such that an audio-only disc reader will see only the primary tracks and not be aware of the existence of the alternate tracks, and such that an optical disc data reader will see only the alternate tracks and not be aware of the existence of the primary tracks.

For each of the reasons discussed above, it is respectfully submitted that Claim 40 is not rendered obvious under §103 by the proposed combination of Babowicz and Alcalay. Claim 40 is thus believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 75

Independent Claim 75 stands rejected under 35 U.S.C. §103 as obvious in view of a proposed combination of teachings from Babowicz and Alcalay. This ground of rejection is respectfully traversed. As noted earlier, MPEP §2142 specifies that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Applicants respectfully submit that Babowicz and Alcalay fail to establish a *prima facie* case of obviousness under §103 with respect to Claim 75, for the following reasons. Claim 75 recites:

A method of controlling access by an optical disc data reader to an optical disc having a session that has a main data channel and a

plurality of sub-code channels, the session including at least one primary track and at least one alternate track formed within the main data channel, the method comprising the step of preventing the location of the, or at least one of the, primary track(s) when the optical disc is read by the said optical disc data reader, and directing the data reader instead to the, or an associated, alternate track.

In the Office Action, the rationale given by the Examiner for the rejection of Claim 75 is effectively the same rationale given for the rejection of Claim 40. Therefore, for reasons similar to those discussed above in association with Claim 40, it is respectfully submitted that the proposed combination of Babowicz and Alcalay will not result in the specific subject matter recited in Claim 75. In particular, the proposed combination does not yield a single session that includes both "primary" tracks and "alternate" tracks in the main data channel of that session, such that an audio-only disc reader will see only the primary tracks and not be aware of the existence of the alternate tracks, and an optical disc data reader will see only the alternate tracks and not be aware of the existence of the primary tracks.

For these reasons, it is respectfully submitted that Claim 75 is not rendered obvious under §103 by the proposed combination of Babowicz and Alcalay. Claim 75 is thus believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 41-64 and 78, Claims 66-74 and 79, and Claims 76-77 respectively depend from Claim 40, Claim 65 and Claim 75, and are also believed to be distinct from the art of record, for example for the same reasons discussed above with respect to Claims 40, 65 and 75, respectively.

Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

Respectfully submitted,



T. Murray Smith
Registration No. 30,222
(972) 739-8647

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HAYNES AND BOONE, LLP
IP Section, Suite 700
2323 Victory Avenue
Dallas, Texas 75219
Telephone: (972) 680-7550
Facsimile: (214) 200-0853
File: 36382.3

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